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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,680	08/30/2000	Anil K. Goyal	410093.401	2023
22504	7590	09/06/2006	EXAMINER	
DAVIS WRIGHT TREMAINE, LLP 2600 CENTURY SQUARE 1501 FOURTH AVENUE SEATTLE, WA 98101-1688			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/651,680

**Applicant(s)**

GOYAL, ANIL K.

**Examiner**

Natalie A. Pass

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 22 June 2006. Claim 28 is pending.

### ***Claim Rejections - 35 USC § 101***

2. Claim 28 is rejected under 35 U.S.C. 101 for substantially the same reasons given in the previous Office Action (paper number 03022006). Further reasons appear hereinbelow.

(A) Claim 28 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 03022006, section 3, page 3), and incorporated herein.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, for substantially the same reasons given in the previous Office Action (paper number 03022006). Further reasons appear hereinbelow.

(A) Claim 28 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 03022006, section 5, page 4-5), and incorporated herein.

5. The rejection of claim 28 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the response filed 22 June 2006.

*Response to Arguments*

6. Applicant's arguments filed 22 June 2006 have been fully considered but they are mostly not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 22 June 2006.

(A) At pages 5-6 of the 22 June 2006 response, Applicant argues that the rejection of claim 28 under 35 USC § 101, for being directed to non-statutory subject matter, should be withdrawn, and argues the “concreteness” of claim 28. Although Applicant’s arguments and explanations attempt to clarify Applicant’s specification and to describe Applicant’s invention as interpreted by a person having ordinary skill in the art, the rejection under 35 USC § 101 deals not with interpretation of the specification by one of ordinary skill in the art, but with the claims as written. As an example, in pages 5-6 of the 22 June 2006 response Applicant discusses a statistical analysis involving groups of participating consumers using Applicant’s invention. However, although there is support in the specification for such statistical analysis to occur, there is no statistical analysis, and in fact, no analysis at all recited in Applicant’s claim language. As such, the claim language does not reflect Applicant’s arguments as to why this claimed invention is statutory, and the rejection under 35 USC § 101 still stands.

(B) At pages 6-10 of the 22 June 2006 response, Applicant argues that the rejection of claim 28 under 35 USC § 112, first paragraph, for lack of enablement, should be withdrawn, and argues the passages in the specification that are pertinent to claim 28. Although Applicant's arguments and explanations attempt to clarify Applicant's specification, and although the "enablement" requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention, Examiner notes that the invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. See MPEP 2164. For example, if an applicant has claimed a process and provided a credible basis for asserting that the process is useful in that regard, but to actually practice the invention as claimed a person skilled in the relevant art would have to engage in an undue amount of experimentation, the claim may be defective under 35 U.S.C. 112, first paragraph. Further, Examiner notes that MPEP 2164.08 states that "[a]ll questions of enablement are evaluated against the claimed subject matter." Therefore although Applicant is correct in stating in paragraph 1 of page 7 of the 22 June 2006 response that "complete accuracy of result is not a requirement for patentability," Examiner interprets Applicant's claimed limitations to be not enabling enough to produce a predictable and repeatable result when executed by one of ordinary skill in the art without undue experimentation.

As per Applicant's discussion on pages 7-10 of the 22 June 2006 response describing enablement of Applicant's invention using statistical analyses involving groups of participating consumers using Applicant's invention, and although there is support in the specification for

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such statistical analysis to occur, there is no statistical analysis, and in fact, no analysis at all in Applicant's recited claim language. As such, and reiterating that "[a]ll questions of enablement are evaluated against the claimed subject matter," (see MPEP 2164.08), the rejection under 35 USC § 112, first paragraph still stands.

(C) Applicant's arguments at pages 10-12 of the 22 June 2006 response that the rejection of claim 28 under 35 USC § 112, second paragraph should be withdrawn are persuasive. Accordingly the rejection under 35 USC § 112, second paragraph has been withdrawn.

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

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For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

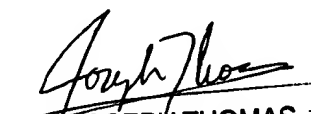
After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

August 31, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER